

## REMARKS

### A. Status of Claims

Claims 4-32 are pending. Claims 4, 10 and 23 are amended herein, and claims 5 and 6 are cancelled herein. Claims 1-3, 7-9, 11-13, 30 and 33 were previously cancelled.

### B. §102 Rejections Citing O'Meara

The Examiner has rejected claims 4, 5, 10 and 14 as being anticipated by U.S. Pat. No. 6,007,219 belonging to O'Meara ("O'Meara"). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers, Inc. v. Union Oil Co. of California*, 2 USPQ2d 1051 at 1053 (Fed. Cir. 1987).

#### 1) O'Meara's Disclosure

O'Meara does not disclose either expressly or inherently that its red and green laser beams are emitted substantially\_simultaneously. Rather, O'Meara discloses a search and rescue flashlight that has different colored lasers for signaling during an emergency. See, e.g., O'Meara column 7, lines 27-65 (discussing Figures 11 and 12). In accordance with the search and rescue operations, a user can select which laser light to operate. See, e.g., O'Meara column 7, lines 36-42 ("The lasers 148 and 152 are selectively chosen by switch means 146.") and column 7, lines 57-61 ("The lasers 174 and 178 are selectively chosen by switch means 164."). Therefore, O'Meara discloses a search and rescue flashlight having red and green laser beams that are emitted alternatively, *not* simultaneously.

#### 2) Applicants' Claimed Invention

In contrast to the laser device described in O'Meara, Applicants' preferred embodiment uses laser beams that are emitted substantially\_simultaneously.

See specification paragraph [0015] and [0023]. Applicants have amended independent claim 4 to clarify that at least two of the laser beams are emitted simultaneously. Claim 10 already contained this limitation. Claim 14 depends from claim 10, so claim 14 also require that at least two laser beams are emitted substantially simultaneously. Claim 5 has been cancelled.

Because the laser beams disclosed in O'Meara are not emitted at the same time, O'Meara does not disclose each and every element as set forth in claims 4, 10 and 14, either expressly or inherently. Accordingly, O'Meara does not anticipate Applicants' claimed invention, and Applicants respectfully request that this rejection be withdrawn.

### **C. §103 Rejections Citing Orosz and O'Meara**

The Examiner has rejected claims 4 and 6 as being obvious in light of U.S. Patent No. 5,836,081 issued to Orosz ("Orosz") in view of O'Meara. Claim 6 has been cancelled, and due to the claim amendments herein, claim 4 now has the limitation that at least two of the laser beams are emitted substantially simultaneously.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the reference or combine the teachings. MPEP §2142. The references must be considered as a whole and there must be something in the prior art as a whole to suggest the desirability of the combination. MPEP §2142.

There is no motivation to combine the teachings of Orosz and O'Meara and no motivation to apply their teachings to the development of therapeutic laser devices. Orosz teaches a laser level that creates laser line shapes for use with orienting a pressure transducer at the tip of a catheter placed at a cardiac patient's heart. O'Meara teaches a search and rescue flashlight having colored lasers for emergency situations. There is no suggestion in either Orosz or O'Meara that their laser device teachings are also instructive for treating the parasympathetic nervous system or for any therapeutic laser application. Additionally, there is no reason to consider using O'Meara's red and green laser

colors in the Orosz device, because the Orosz device is mainly concerned with orientating medical equipment with respect to laser lines. There is no suggestion in Orosz that multiple colors would be helpful or useful. Likewise, there is no reason to consider simultaneously operating the red and green lasers in O'Meara because in O'Meara the search and rescue flashlight uses particular colors at particular times as signals. There is no suggestion in O'Meara that it would be helpful to operate multiple lasers simultaneously. Accordingly, there is no motivation to combine the laser line level of Orosz with the color coded search and rescue flashlight of O'Meara. Additionally, there is no motivation to consider either of these devices when designing therapeutic laser devices.

Because there is no motivation to combine the teachings of Orosz and O'Meara or apply them to therapeutic laser devices, a *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request that this rejection be withdrawn.

#### **D. §103 Rejections Citing Yayama and Gerdes**

The Examiner has rejected claims 10 and 15-19 as being obvious in light of U.S. Patent No. 6,582,454 issued to Yayama ("Yayama") in view of U.S. Patent No. 6,267,779 issued to Gerdes ("Gerdes"). A claim is *prima facie* obvious only if the prior art reference (or references when combined) teach or suggest all the claim limitations. *MPEP* §2143. Claims 10 and 15-19 all include the limitation that laser sources be housed in a hand-held device.

Neither Yayama nor Gerdes suggests housing the laser sources in a hand-held device. While Yayama teaches that three colors of lasers can be used for treating a patient, it does not suggest that its laser sources should be in one housing, multiple housings, or any housing at all. Rather, Yayama just refers to a "laser beam generating part 1" that is separate from a "projecting part 3." See, e.g., Yayama column 3, lines 63-67 (referring to Figures 2 and 3). Similarly, Gerdes teaches that a laser source can be in a cabinet and travel by fiber optic cable to a separate wand. See, e.g., Gerdes column 8, lines 23-25 (describing how treatment wands are connected by fiber optic cables to laser sources

residing in a cabinet). There is no suggestion in Gerdes that placing the laser source in a hand-held wand would be desirable.

Because neither Yayama nor Gerdes suggests housing the laser sources in a hand-held device, a *prima facie* case of obviousness has not been established and Applicants respectfully request that this rejection be withdrawn.

**E. §103 Rejections Citing Yayama and Tatebayashi**

The Examiner has rejected claims 20-26, 29 and 31-32 as being obvious in light of Yayama in view of U.S. Patent 5,150,704 to Tatebayashi et al. ("Tatebayashi"). A claim is *prima facie* obvious only if the prior art reference (or references when combined) teach or suggest all the claim limitations. *MPEP* §2143. Claims 20-26, 29 and 31-32 all require that an arm that is freely positionable in all three axes house the plurality of laser energy sources and that the arm have optical arrangements attached thereto for creating spot shapes.

Neither Yayama nor Tatebayashi discloses or suggests the use of a freely positionable arm that houses a plurality of laser energy sources on a stand-alone device. As discussed in Section D above, Yayama does not include any discussion of whether its laser sources should be in one housing, multiple housings, or any housing at all. Tatebayashi teaches a moveable arm, but the arm is merely a support structure for multiple wands. See Tatebayashi column 4, lines 32-69 and Figures 4 and 5 (discussing and illustrating "probe support table 5"). In Tatebayashi, no components of the laser probe are housed within the arm. See, e.g., Tatebayashi column 8, lines 6-21 (describing the components of the probe shown in Figure 11, including the laser source). Accordingly, neither Yayama nor Tatebayashi contemplates that it would be desirable to house multiple laser energy sources in an arm that is freely positionable in all three axes.

Further, neither Yayama and Tatebayashi disclose or suggest using optical arrangements to create various spot shapes for each laser. In Yayama, the beams emitted by its lasers are condensed to shine together at one location. See Yayama column 5, lines 55-59. While the beams are directed to shine

together, Yayama never suggests using optical arrangements to create spot shapes for either the condensed beams or for each of the beams independently. Similarly, Tatebayashi also does not address consider optical arrangements for creating spot shapes. Accordingly, neither Yayama nor Tatebayashi contemplates that it would be desirable to include optical arrangements for creating spot shapes.

Because neither Yayama nor Tatebayashi suggests housing the plurality of laser energy sources in a freely positionable arm and because neither Yayama nor Tatebayashi suggests using optical arrangements for creating spot shapes for each laser, a *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request that this rejection be withdrawn.

#### **F. §103 Rejections Citing Yayama, Tatebayashi, and Gerdes**

The Examiner has rejected claims 27 and 28 as being obvious in light of Yayama in view of Tatebayashi and further in view of Gerdes. A claim is *prima facie* obvious only if the prior art reference (or references when combined) teach or suggest all the claim limitations. *MPEP* §2143. Claims 27 and 28 all require that an arm, freely positionable in all three axes, house the plurality of laser energy sources.

As discussed in Section E above, neither Yayama nor Tatebayashi discloses or suggests the use of a freely positionable arm that houses a plurality of laser energy sources on a stand-alone device. Similarly, Gerdes fails to disclose or teach a freely positionable arm that houses multiple laser sources. Gerdes merely teaches using multiple wands connected by fiber optics to laser sources located in a remote cabinet. See, e.g., Gerdes column 8, lines 23-25 (describing how treatment wands are connected by fiber optic cables to laser sources residing in a cabinet).

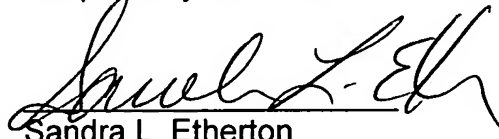
Because Yayama, Gerdes and Tatebayashi do not suggest housing the plurality of laser energy sources in a freely positionable arm, a *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request that this rejection be withdrawn.

### CONCLUSION

Applicant respectfully submits that all objections and rejections have been traversed, and that the application is in form for issuance. Applicant respectfully requests that the Examiner allow the application to proceed to issuance.

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Respectfully submitted,



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